

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Attorney Docket No. 295620214063
Gordon E. Hardman et al.)	
)	
Application No.:)	
09/916,028)	
)	
Filed:)	
July 26, 2001)	
)	
For:)	
ELECTRONIC TIRE)	
MANAGEMENT SYSTEM)	
)	
Examiner:)	
Phung Nguyen)	
)	
Art Unit:)	
2632)	
)	
Confirmation No.:)	
7425)	

REMARKS

Claim 122 has been cancelled so that claims 1-121 and 123-141 are now in the application.

Claims 1, 40, 100, 107, 110, 114, 122, 123, 130, 137 and 138 are rejected under section 101 for claiming the same invention (double patenting) as that claimed in claims 1, 39, 92, 93, 97 and 101 of U.S. Patent No. 6,630,885 ("the '885 patent"). This rejection is respectfully traversed as explained below in relation to each of the rejected claims.

Relevant Law

In the case of *Application of Vogel*, 422 F.2d 438 (CCPA 1970), a double patenting rejection under 35 U.S.C. §101 is based on the concept that the same invention cannot be claimed twice. According to the court, "invention" means that which is "defined by the claims, whether new or old, obvious or unobvious. . ." The court goes on to state that a good test of whether there is the "same invention" is "whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same

invention." A finding of literal infringement requires that the claims read on an accused product.

Morton International, Inc. v. Cardinal Chemical Co., 5 F.3d 1464 (Fed. Cir. 1993). And, a claim reads on an accused device if the device embodies every limitation of the claim. *Carroll Touch, Inc. v. Electro Mechanical Systems Inc.*, 3 F3d 404 (Fed. Cir. 1993).

Claims

Claim 1 of the application does not recite the same invention as stated in claim 1 of the '885 patent because claim 1 of the application has been amended to remove the limitation "at a first location". Therefore, claim 1 of the application is broader than claim 1 of the '885 patent.

Claim 40 of the application does not recite the same invention as claim 39 of the '885 patent because claim 39 of the patent includes the limitations that "the microprocessor periodically partially awakens to examine, on a second periodic basis, a transmission and to at least partially identify the transmission as an interrogation signal from a reader/transceiver (RT) at the second location." Claim 40 of the application states that the microprocessor partially awakens "to a search mode" and to "further awakening" under certain circumstances. These limitations are not found in claim 39 of the '885 patent.

Claim 39 of the '885 patent also includes the limitations of "a search mode" and "an interrogation mode". In search mode, the microprocesor is to "verify." These limitations are not found in claim 40 of the application.

Claim 100 of the application does not set forth the same invention as claim 92 of the '885 patent because claim 92 includes the limitations that the sensor is for "generating a data signal representing the measured parameter", and that "the microprocessor on a periodic basis causing the tire tag to enter a lucid sleep mode in which certain of the electrical components are activated to cause the sensor to measure and store the at least one tire parameter" and "the microprocessor periodically partially awakening and looking for a forward link transmission and if detected

causing the tire tag to determine whether the forward link transmission is a valid interrogation signal and if so causing the tire tag to enter an interrogation mode where the microprocessor activates all the necessary electrical components to receive, process and respond to a valid interrogation signal". Claim 100 does not have these recited limitations.

Claim 107 of the application does not recite the same invention as claim 93 of the '885 patent because claim 107 does not include the limitation found in claim 93 that the device is "at a first location."

Claim 110 of the application does not recite the same invention as claim 96 of the '885 patent because claim 110 includes the limitation "a tire tag mounted in a tire", a limitation not found in claim 96 of the '885 patent. Furthermore, claim 96 of the '885 patent includes limitations not found in claim 110 of the application, such as, the tire sensor "generating a data signal representing the measured tire parameter", "a memory for storing one or more parameter thresholds", "a tag transmitter for transmitting an RF signal", "the microprocessor to measure the tire parameter, comparing the measured tire parameter with one or more stored parameter thresholds, generating an alert signal if the measured parameter is outside of the one or more parameter thresholds, and in response to the alert signal causing the transmitter to transmit an alarm signal that indicates that the tire parameter is outside of one or more parameter thresholds," and "a printed circuit board". In addition, claim 110 of the application includes the limitation of "a transmitter for transmitting data signals using frequency shift key (FSK) modulation." There are other limitations in claim 110 of the application not found in claim 96 of the '885 patent as well.

Claim 114 of the application does not recite the same invention as claim 97 of the '885 patent because claim 97 includes the limitation of "mounting a tire tag on the inside of a tire",

"periodically causing the tire tag to partially awaken on a first periodic basis to measure one or more parameters of the tire", "storing the measured parameters", and "periodically causing the tire tag to partially awaken to determine, on a second periodic basis, if a received transmission is a valid interrogation signal and, if so, fully awakening and responding to the valid interrogation signal, via the transmitter, by at least transmitting the measured parameters to a remote reader/transceiver (RT)."

Claim 122 has been cancelled so that the rejection is obviated.

Claim 123 does not recite the same invention as claim 101 of the '885 patent because claim 101 of the '885 patent includes the limitation of a microprocessor programmed to "store the cold fill temperature" and "measure the hot inflation pressure and temperature of the vehicle tire during operation of the tire. . .using the ideal gas equation." This limitation is not present in claim 123.

Claim 130 of the application, "an interrogator", has no counterpart in the '885 patent.

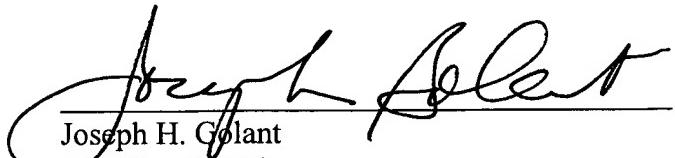
Claim 137 of the application does not recite the same invention as claim 39 of the '885 patent because claim 39 has six limitations not found in claim 137, namely, "a microprocessor. . .for activating the sensor on a first periodic basis", "the microprocessor periodically partially awakening to examine a transmission", "a search mode" and "an interrogation mode". Further, claim 137 is a system for measuring a "vehicle" parameter whereas claim 39 is a system for measuring a "tire" parameter.

Claim 138 of the application recites a different invention from claim 93 of the '885 patent because claim 138 relates to measuring a "vehicle" parameter and not a "device parameter," and claim 93 recites a transmitter for "transmitting the alarm signal", a limitation not found in claim 138. Claim 138 includes a "receiver", a limitation not found in claim 93.

In view of the cancellation of claim 122 and the above comments regarding the remaining rejected claims, the Examiner is respectfully requested to reconsider the rejections and indicate allowance.

Dated: April 7, 2006

Respectfully submitted,



Joseph H. Golant
Reg. No. 24,210
JONES, DAY, REAVIS & POGUE
77 West Wacker Drive
Chicago, Illinois 60601-1692
(312) 269-1534